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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/431,888	11/02/99	WISE	L 1064/44803

HM22/0824
EVENSON MCKEOWN EDWARDS & LENAHAH PLLC
1200 G STREET N W
SUITE 700
WASHINGTON DC 20005

EXAMINER

ANDRES, J

ART UNIT

PAPER NUMBER

1646

15

DATE MAILED:

08/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/431,888

Applicant(s)

WISE ET AL.

Examiner

Janet L Andres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 8-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Applicant's amendment in paper no. 14, filed 19 April 2001, is acknowledged. Claims 1-52 are pending in this application. Claims 8-52 are withdrawn from consideration as being drawn to a non-elected invention. The restriction requirement of paper no.8, mailed 18 August 2000, is made FINAL.

2. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Claim Rejections/Objections Withdrawn

3. The rejection of claims 1-7 under 35 U.S.C. 112, first paragraph, is withdrawn in response to Applicant's argument that VEGFR2 is expressed on precursor mesodermal cells and Applicant's declaration under 37 C.F.R. 1.132, providing evidence of NZ10 function.

4. The rejection of claims 1-7 under 35 U.S.C. 112, second paragraph, is withdrawn in response to Applicant's arguments.

Claim Rejections Maintained/New Grounds of Rejection

5. The rejection of claims 1-7 under 35 U.S.C. 103(a) as unpatentable over Lyttle et al. in view of Thomas is maintained.

The Examiner agrees that neither reference teaches NZ10 and that non-obviousness of the invention with respect to this protein is clear. However, the claims encompass both NZ10 and ORFV2-VEGF. Applicant argues that sequence homology provides no additional information on function, and that the preliminary study taught by Lyttle et al. does not give rise to a reasonable expectation of success because it was conducted with cell supernatants. Applicant further argues that the Thomas reference does not correct the deficiencies in the Lyttle reference,

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since the Lyttle reference does not teach the use of ORFV2-VEGF to stimulate proliferation of endothelial cells and induce vascular permeability.

Applicant's arguments have been fully considered but have not been found to be persuasive. The courts have held that

In considering the disclosure of a reference, it is proper to take into account not only specific teaching of the reference but also the inferences which one skilled in the art would be reasonably be expected to draw therefrom In re Preda, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968).

and

Specific statements in the references themselves which would spell out the claimed invention are not necessary to show obviousness, since questions of obviousness involves not only what references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. See CTS Corp. v. Electro Materials Corp. of America 202 USPQ 22 (DC SNY); and In re Burckel 201 USPQ 67 (CCPA).

Lyttle et al. teaches that the viral protein shares homology with mammalian VEGF.

Lyttle et al. further teaches that supernatants from cells infected with the virus are mitogenic for vascular endothelial cells, and that the lesions seen in infected sheep and humans are typified by extensive capillary proliferation. Lyttle et al. concludes that "it seems likely that the response is a direct effect of a VEGF-like protein" (p. 91). Thus, while the Examiner agrees that sequence homology, absent any other teachings, is not necessarily predictive of function, what is taught by Lyttle et al. is both sequence homology to VEGF and activity characteristic of VEGF. One of ordinary skill in the art would thus reasonably conclude that the observed activity was due to the VEGF homologue, and would expect this homologue to function like VEGF. Lyttle et al. explicitly suggests such a conclusion. Thus it would be *prima facie* obvious to one of ordinary skill in the art to use ORFV2-VEGF to stimulate proliferation of endothelial cells and induce

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vascular permeability, as taught for VEGF by Thomas et al., with an expectation of similar results.

NO CLAIM IS ALLOWED.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 305-3014 or (703) 308-4242.

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Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.
August 21, 2001

Gary L. Kunz
GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600